

### **REMARKS**

Claims 19-68 are pending. Claims 19, 20, 29, 39, 43, 44, and 52 have been amended. No claims have been added or cancelled. Claims 36-51 and 57-68 are withdrawn from consideration as being directed to a non-elected species.

Applicant appreciates the Office Action's acknowledgement that claims 21, 22, 24, 26, 28, and 31 recite allowable subject matter. For the reasons provided below, Applicant respectfully submits, however, that all of the pending claims are allowable over the art of record.

Claim 19 stands rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,738,171. Applicant respectfully requests that the rejection be withdrawn or held in abeyance until the Examiner believes the claims are otherwise in condition for allowance since amendments to the claims during the course of prosecution may obviate the rejection. If the Examiner believes the pending application is in condition for allowance but for the double patenting rejection of claim 19, then the Examiner is invited to telephone Applicant's representative at the number below to discuss filing a Terminal Disclaimer to obviate the rejection.

Claims 19, 20, 23, 25, 27, 29, 30, 32-35, and 52-56 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,274,914 ("Fan"). The rejection is respectfully traversed.

Claim 19 recites a device, comprising: "an array of sensing pixels ... wherein said sensing pixels are formed of multiple pixel layers and at least one of said multiple pixel layers comprises an electrically conductive in-pixel circuit element ... wherein said at least one of said multiple pixel layers comprising an electrically conductive in-pixel circuit element is formed over said optical mask layer."

Applicant and Examiner disagree on the meaning of the term "in-pixel circuit element," as recited in claim 19. In making out a rejection over Fan, the Office Action equates the

“encapsulant and planarization layer 50” disclosed by Fan with the “in-pixel circuit element” claimed by Applicant. In a response filed on November 6, 2008, Applicant pointed out that the specification of the pending application describes a “pixel layer” as “fabricated through semiconductor fabrication to form *in-pixel circuit elements such as electrodes for the photoreceptor*” and argued that the “encapsulant and planarization layer 50” could not be reasonably characterized as such. The Office Action now asserts that Applicant is relying upon features not recited in the claims and notes that, “[a]lthough the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.” See *In re Van Geuns*, 988 F.2d 1181 (Fed. Cir. 1993).

The Office Action is correct, of course, that limitations from the specification must not be read into the claims. Applicant did not propose to do so here. The term “in-pixel circuit element” appears expressly in claim 19. The question, and disagreement between Applicant and Examiner, concerns the proper construction of this claim term. On this issue, it is entirely appropriate to look to the specification. “[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Although USPTO examiners employ a more relaxed claim construction standard than the courts, the resulting construction must still be “reasonable.” MPEP § 2106 (citing *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997)).

Applicant’s position was simply that a person of ordinary skill in the art would, at the time of the invention, not have understood the term “in-pixel circuit element” as encompassing a non-conductive encapsulant and planarization layer formed atop a color filter array. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005), *cert. denied*, 546 U.S. 1170 (2006) (The words of a claim are generally given their “ordinary and customary” meaning, which “is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention....”). As evidence to support Applicant’s contention that one of ordinary skill in the art would understand “in-pixel circuit element” to mean an electrically conductive element,

Applicant directs the Examiner's attention to a definition of "circuit" provided in the IEEE Dictionary – "An arrangement of interconnected *electronic components* that can perform specific functions upon application of proper voltages and signals." The Authoritative Dictionary of IEEE Standards Terms, 7th Edition (2000) (emphasis added). This definition is consistent with the specification's statement that "electrodes for the photoreceptor" and "transistors for the signal conversion or amplification" are exemplary of "in-pixel circuit elements" and entirely inconsistent with the Office Action's assertion that a one of ordinary skill in the art would understand an "in-pixel circuit element" to include a non-conductive encapsulant and planarization layer formed atop a color filter array. Applicant respectfully submits that the overly broad construction of "in-pixel circuit elements" adopted by the Office Action is unreasonable and, therefore, improper, even under the more relaxed claim construction standard applicable during examination.

Despite Applicant's disagreement with the Office Action's claim construction, Applicant has amended claims 19 and 52 to explicitly recite an "electrically conductive in-pixel circuit element" to advance prosecution of this application. Because the term "in-pixel circuit element" alone would have been understood by one of ordinary skill in the art to imply electrical conductivity, this amendment does not change the scope of the claim or raise new issues. Therefore, the amendment should be entered without a Request for Continued Examination. The non-conductive encapsulant and planarization layer 50 of Fan cited by the Office Action is clearly not an "electrically conductive in-pixel circuit element," as claimed.

For at least these reasons, the claim 19 is believed to be allowable over Fan. Therefore, the rejection of claim 19 should be withdrawn.

Claims 20-35 depend from claim 19 and are believed to be allowable over Fan for at least the reasons stated above with respect to claim 19 and on their own merits. Therefore, the rejection of claims 20-35 should be withdrawn.

Claim 52 recites limitations similar to those of claim 19 quoted above and is believed to be allowable over Fan for at least the reasons stated above with respect to claim 19 and on its own merits. Therefore, the rejection of claim 52 should be withdrawn and the claim allowed.


Claims 53-56 depend from claim 52 and are believed to be allowable over Fan for at least the reasons stated above with respect to claim 52 and on their own merits. Therefore, the rejection of claims 53-56 should be withdrawn.

Claims 21, 22, 24, 26, 28 and 31 stand objected to, but are otherwise allowable. Claims 21, 22, 24, 26, 28 and 31 depend from claim 19, which is believed to be allowable. Accordingly, the objection should be withdrawn.

In view of the above, Applicant believes the pending application is in condition for allowance and respectfully requests that it be passed to issue.

Dated: March 13, 2009

Respectfully submitted,

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